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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,950	03/27/2001	Paul M. Guyre	DC-0153	4097

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EXAMINER

BELYAVSKYI, MICHAEL A

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 08/13/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,950

Applicant(s)

GUYRE ET AL.

Examiner

Michail A Belyavskiy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/23/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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RESPONSE TO APPLICANT'S AMENDMENT

1. The examiner of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Michail Belyavskyi, Art Unit 1644, Technology Center 1600

Applicant's amendment, filed 5/23/02 (Paper No. 8), is acknowledged.

2. Claims 1-4 are pending.

Claims 1-4 are under consideration in the instant application.

In view of the amendment filed 5/23/02 (Paper No. 8), the following rejections remain:

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 2 stands rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the same reasons set forth in the previous Office Action, paper No: 7 mailed on 02/25/02.

Applicant's arguments, filed 5/23/02 (Paper No. 8), have been fully considered, but have not been found convincing.

(A) Applicant asserts that antibodies are commercially available from Maine Biotechnology.

The Office will accept commercial availability as evidence that a biological material is known and readily available only when the evidence is clear and convincing that the public has access to the material. A product could be commercially available but only at a price that effectively eliminates accessibility to those desiring to obtain a sample. The relationship between the applicant relying on a biological material and the commercial supplier is one factor that would be considered in determining whether the biological material was known and readily available. However, the mere fact that the biological material is commercially available only through the

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patent holder or the patent holder's agents or assigns shall not, by itself, justify a finding that the necessary material is not readily available, absent reason to believe that access to the biological material would later be improperly restricted.

(B) The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See In re Hawkins, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); In re Hawkins, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and In re Hawkins, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112; however this does not bar incorporation by reference. *Ex parte Schwarze*, 151 USPQ 426 (Bd. of Appeals, 1966). "Essential material" is defined as that which is necessary to (1) support the claims, or (2) for adequate disclosure of the invention (35 U.S.C. 112).

The attempt to incorporate subject matter into this application by reference to Hogger et al. (*Pharm. Res.* 1998; 15: 296-302) for the monoclonal antibody RM3/1 on page 4, line 14 of the specification is improper because an application for a patent when filed may incorporate "essential material" by reference to (1) a United States patent or (2) an allowed U.S. application, subject to the conditions set in the MPEP 608.01(p)".

It is noted that applicant has not addressed this issue.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 1-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Coligan et al. (Current Protocols in Immunology, Greene Publishing Associates and Wiley-Interscience, New York, 1991; pages 2.1.1-2.1.3, 2.1.9-2.1.11, and 2.1.17-2.1.22) in view of U.S. Patent 5,077,216, and Zwadlo et al (IDS Reference BA) and the known fact disclosed in the specification on page 4, paragraph 1 for the same reasons set forth in the previous Office Action, Parer NO:7, mailed on 02/25/02.

Applicant asserts that although the antibodies MAC2-158 and MAC2-48 as a CD163 capture antibodies and RM3/1 as a CD163 detection antibody, as well as ELISA as a general technique for antigen detection were taught in the art at the time the invention was made, there was no motivation or suggestion to combine these teachings.

Contrary to Applicants assertion, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the antibodies taught by the '216 patent as capture antibodies and the antibodies taught by Zwadlo et al. as the detection antibody in the ELISA assay taught by Coligan et al. to have a method for detecting the presence of CD163 in a biological sample comprising contacting the sample with a CD163 capture antibody to form a CD163 antibody complex and contacting said complex with a detection antibody so that the levels of CD163 in the sample are detected, and to use the method as discussed herein to have a method for monitoring the course of an inflammatory condition or inflammatory comprising detecting the presence of CD163 in biological samples as taught by Zwadlo.

One of ordinary skill in the art would have been motivated to substitute the antibodies taught by the '216 patent and Zwadlo et al. in the ELISA taught by Coligan et al. to detect and monitor the presence of CD163 in a biological sample, such as human plasma, during an inflammatory condition/process Antibody-Sandwich ELISA to detect soluble antigens, which is the most useful of the immunosorbent assays for detecting antigen because it is very sensitive and ELISAs are useful for screening biological fluids (e.g. from plasma) for antigen content as taught by Coligan et al. and monitoring the course of an inflammatory condition by detecting CD163 (i.e. RM3/1 antigen) such as rheumatoid arthritis is important as taught by Zwadlo et al.

11. No claims are allowed.

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12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskyi whose telephone number is (703) 308-4232. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Michail Belyavskyi, Ph.D.
Patent Examiner
Technology Center 1600
August 17, 2002


CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600